



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/772,196	02/04/2004	Michael L. Jordan	050704/305124	4228

826 7590 02/05/2009
ALSTON & BIRD LLP
BANK OF AMERICA PLAZA
101 SOUTH TRYON STREET, SUITE 4000
CHARLOTTE, NC 28280-4000

EXAMINER

PORTER, RACHEL L

ART UNIT	PAPER NUMBER
----------	--------------

3626

MAIL DATE	DELIVERY MODE
-----------	---------------

02/05/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/772,196

Applicant(s)

JORDAN, MICHAEL L.

Examiner

RACHEL L. PORTER

Art Unit

3626

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 October 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 3-6 and 9-17 is/are pending in the application.
- 4a) Of the above claim(s) 10-17 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 3-6 and 9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Notice to Applicant

1. The communication is in response to the application filed 10/16/08. Claims 1, 3-6, 9 -17 are pending.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1,3-6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 has been amended to recite "wherein if the prescription is fillable in an automated manner, said set of workstations excludes a pharmacist review workstation and otherwise said set of workstations includes a pharmacist review workstation."

The phrase " otherwise said set of workstations includes a pharmacist review workstation." In particular, the current phrasing/claim language renders unclear the extent to which the prescription filling process is "automated" in independent claim 1 and in the additional dependent claims. In other words, it is unclear whether the prescriptions are merely put aside for manual review by a pharmacist, but are otherwise filled in an automated (e.g. robotic) manner, or if they are filled in an entirely different (manual) process.

Claims 3-6 inherit the deficiencies of claim 1 through dependency, and are also rejected.

Election/Restrictions

Newly submitted claims 10-17 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: The inventions are distinct, each from the other because of the following reasons:

4. Invention I (claims 1, 3-6, and 9) and Invention II (claims 10-17) are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another and materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case, the current the process(-es) as claimed can be practiced by another and materially different apparatus or by hand. In particular, it is appears from the process claims that no "automation" or computer involvement is required in the evaluation/determination steps, and during the steps of filling the prescription. This is contrary to the current claim language of claim 10.

5. Restriction for examination purposes as indicated is proper because all these inventions listed in this action are independent or distinct for the reasons given above and there would be a serious search and examination burden if restriction were not required because one or more of the following reasons apply:

- (a) the inventions have acquired a separate status in the art in view of their different classification;

- (b) the inventions have acquired a separate status in the art due to their recognized divergent subject matter;
- (c) the inventions require a different field of search (for example, searching different classes/subclasses or electronic resources, or employing different search queries);
- (d) the prior art applicable to one invention would not likely be applicable to another invention;
- (e) the inventions are likely to raise different non-prior art issues under 35 U.S.C. 101 and/or 35 U.S.C. 112, first paragraph.

Should applicant traverse on the ground that the inventions are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 10-17 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claim 9 is rejected under 35 U.S.C. 102(e) as being anticipated by Hebron.

[claim 9] Hebron teaches a method of operating a prescription filling line of the type having automated equipment and non-automated equipment for filling prescriptions, comprising:

- evaluating a queue of orders to determine whether each prescription within each order is fillable in an automated manner; (Figure 9; par. 92-96)
- selecting an appropriate sized end user container; (Figure 9; par. 51, 92-94, 101)
- printing and applying a label to said container; (Figure 9; par. 51, 92-94, 101)
- inserting the labeled container into a carrier; (Figure 9; par. 51, 92-94, 101)
- routing the carrier to a prescription filling station; (par. 92-94, 101)
- routing the carrier to an imaging workstation; and where said order has been filled by automated equipment, routing each carrier for said order to a packing workstation without a review by a pharmacist, (Figure 9: par. 101-106 ; 109-111,

Art Unit: 3626

- and where said order has at least one prescription filled by non-automated equipment, routing each carrier for said order to a pharmacist workstation before routing each carrier to the packing workstation. (par. 50, 90,95—steps whereby the prescription may be pulled for non-automated handling if there is a problem indicated with Rx data)

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

9. Claims 1, 3-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hebron et al (US 2003/0066841 A1) in view of Spaulding et al (US 5,337,919).

[Claim 1] Hebron discloses a method of discriminating between orders, comprising:

- evaluating a queue of orders based on whether each prescription within the order are fillable in an automated manner; and (Figures 9-10; par. 90-96;110—evaluating a patient queue from host computer)
- determining a set of workstations for each prescription based on said evaluating. (par. 90-96, 98,110)

Claim 1 has been amended to recite “wherein if the prescription is fillable in an automated manner, said set of workstations excludes a pharmacist review workstation and otherwise said set of workstations includes a pharmacist review workstation.”

Hebron discloses a method wherein a pharmacist is alerted if there is a disruption in the automated filling of the prescription (par. 110), but does not expressly disclose that "if the prescription is fillable in an automated manner, said set of workstations excludes a pharmacist review workstation and otherwise said set of workstations includes a pharmacist review workstation."

Spaulding discloses a method wherein prescriptions may be sent to a separate pharmacist review workstation for further processing if there is a discrepancy and the automated process cannot continue (e.g. the rx is not fillable in an automated manner). (col. 11: 61-97 ; col. 15:5-25) At the time of the applicant's invention, it would have been obvious to one of ordinary skill in art to modify the method of Hebron with the teaching of Spaulding. As suggested by Spaulding, one would have been motivated to include this feature to enhance the productivity of a pharmacist by robotically performing the tedious aspects of filling prescriptions, thereby allowing the pharmacist to better concentrate on entering prescription data, checking the filled prescription and counseling customers. (col. 5:19-25)

[claim 3] Hebron teaches the method of claim 1 additionally comprising selecting an appropriate sized end user container, printing and applying a label to said container, inserting the labeled container into a carrier, and routing the carrier among the determined set of workstations. (Figure 9; par. 51, 92-94, 101)

[claim 4] Hebron discloses the method of claim 3 wherein said routing includes routing the carrier from a dispensing workstation, to an imaging workstation, and to a capping workstation. (Figure 9: par. 101-106 ; 109-111, 113]

[claim 5] Hebron discloses the method of claim 4 additionally comprising tracking multiple prescriptions that belong to one order and grouping all the prescriptions that belong to one order for shipping. (par. 16—orders accumulate for pick-up or delivery to one patient)

[claim 6] Hebron discloses the method of claim 4 additionally comprising routing the carrier to a packing workstation where a patient specific document is printed and inserted into a labeled bag along with the patient's prescription. (par.16, 51—drug order labeled with warnings and drug description documents.)

Response to Arguments

10. Applicant's arguments with respect to claim 1,3-6, and 9-17 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to RACHEL L. PORTER whose telephone number is (571)272-6775. The examiner can normally be reached on M-F, 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, (Christopher) Luke Gilligan can be reached on (571) 272-6770. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/R. L. P./
Examiner, Art Unit 3626

/C Luke Gilligan/
Supervisory Patent Examiner, Art Unit 3626